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EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,302

Applicant(s)

CHILDRESS, ALLEN B.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 23 June 2000. Claims 1-110 are pending. The IDS statement filed 12 July 2002 has been entered and considered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because the length exceeds 150 words. Correction is requested. See MPEP § 608.01(b).

Claim Objections

4. Claim 28 is objected to because of the following informalities: it appears claim 28 lines 4-5 "...occur in the each of help information in each of the located first plurality of

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help information entries..." is grammatically incorrect. Appropriate correction is requested.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 81-110 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 81, 88, 95, 100, and 108 appear to be directed toward a carrier medium comprising program instructions, wherein the program instructions are computer-executable to implement a series of steps. However, it is unclear as to which recognized statutory class of invention the carrier medium of claims 81, 88, 95, 100, and 108 are directed. In particular, a carrier medium is not a process or method as it lacks a series of steps. A carrier medium is not a machine or system as there is no specific recitation of machine or system components. A carrier medium is not recognized as a composition of matter. A carrier medium, per se, is merely a data structure.

Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and

tangible result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). However, the claims, as presently recited, do not appear to have a tangible result. Data structures or computer programs, in general, that are not claimed as embodied in computer-readable media are descriptive material per se, and are not statutory because they are not capable of causing a functional change in a computer.

In particular, it is unclear whether the program instructions, as recited in claims 81, 88, 95, 100, and 108, are embodied on a specific readable medium within the technological arts (and thus tangible). Such claimed instructions do not define any structural or functional interrelationships between the program instructions and carrier medium, which permit the purpose of the instructions to be realized (see MPEP section 2106 IV, B, 1, (a) for further guidance). Simply stated, how are the claimed program instructions tangibly embodied within the carrier medium?

In light of the above, it is respectfully submitted that the claimed invention, although useful and concrete, is not tangible, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

(B) Claims 82-87, 89-94, 96-99, 101-107, and 109-110 incorporate the deficiencies of claims 81, 88, 95, 100, and 108 through dependency, and are therefore, rejected as well.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (5,655,085) in view of Brooks et al. (4,992,972).

(A) As per claims 1 and 8, Ryan discloses a method using a digital computer for initiating, processing, preparing, storing, and transmitting illustrations of universal life insurance, wherein the computer is operable by connecting to a database and at least one other digital computer, including input and display apparatus to permit data to be entered in and retrieved from the database (Abstract) comprising:

(a) entering first data representing a first universal life insurance policy (col. 48 lines 8-41); and

(b) providing a computerized help system, preferably a context sensitive, hypertext-linked help system, available from any screen in the system, wherein the system includes a FMA_HELP entity containing all context sensitive, hypertext linked help records including context keywords and hyperlink keywords in addition to the help text that enables these features, and wherein the entity is part of a relational database (reads on "an index table") (Fig. 3C-1 and 4A, col. 14 lines 37-40, col. 23 lines 1-5, col. 24 lines 1-20, and col. 26 lines 20-50).

Ryan fails to expressly disclose the computerized help system functionality (i.e., how the help system works). Brooks discloses a method for providing on-line information such as help text for an application combining context sensitive and keyword, or index sensitive, access modes, wherein the application may include various types of programs, wherein a user uses the application for processing a particular command, including entering data for each text line for a parameter of the command, wherein the user moves a display cursor to input fields, wherein when all input fields have been completed, the user presses the "enter" key, the operating system accepts the parameters and performs the specified command, wherein if the user wishes help, the user presses the keyboard "help" key, wherein if at that time the cursor is located in the input field of one of the parameters, then the task panel is overlaid on the display screen with a help-text panel containing text describing the parameter whose field the cursor is located in, and wherein if the cursor is not in any of the input fields of the panel, then pressing the Help key brings up a help-text panel which describes the command generally in text lines (Fig. 4, col. 1 lines 23-34, col. 2 lines 18-33, col. 2 line 65 to col. 3 line 2, col. 3 line 23 to col. 4 line 58, col. 6 line 36-46, col. 7 lines 42-49, col. 8 lines 14-21, col. 9 lines 53-57, col. 10 lines 4-36, and col. 10 line 47 to col. 11 line 42). Furthermore, Brooks includes each input-field specification having individual entries for determining the location (LOC) of the field (reads on "page identifier"), wherein each help-area entry containing the LOC also includes a name which corresponds to the name of a particular help module in a help object (Fig. 4, col. 1 lines 23-34, col. 2 lines 18-33, col. 2 line 65 to col. 3 line 2, col. 3 line 23 to col. 4 line 58, col. 6 line 36-46, col. 7

lines 42-49, col. 8 lines 14-21, col. 9 lines 53-57, col. 10 lines 4-36, and col. 10 line 47 to col. 11 line 42).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Brooks within the method of Ryan with the motivation of reducing the need for paper documentation for the application program (col. 2 lines 18-27) and providing an easy and flexible method for providing general information about an entire display screen, or zooming in to more specific help when the user places a cursor in a particular area of the screen dealing with the aspect of the display the user wishes to study in more detail (Brooks; col. 1 lines 19-34).

(B) As per claim 2, Brooks discloses a plurality of command panel definitions stored in the system, wherein at least some of the command panel definitions have a help area contained within, wherein the help area includes a set of help area entries each associating a help module with a location area for the cursor, wherein a context sensitive selection means, coupled to a display and to an input device, is used for selecting a help module which the command panel definition associates with a location area containing the cursor, and wherein the context sensitive selection means may select more than one module, and wherein the help display means further comprises means for scrolling between different selected modules responsive to commands received from the user via the input device (col. 10 line 48 to col. 12 line 18). The remainder of claim 2 repeats the same limitations as claim 1, and is therefore rejected

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for the same reasons given for claim 1. The motivation for combining Brooks into Ryan is given above in claim 1, and incorporated herein.

(C) As per claim 3, Brooks discloses sorting module names into an ordered list sequenced according to how many times its TOPIC was accessed in the topic table (col. 10 lines 17-36). The remainder of claim 3 repeats the same limitations as claim 1, and is therefore rejected for the same reasons given for claim 1. The motivation for combining Brooks into Ryan is given above in claim 1, and incorporated herein.

(D) As per claims 4 and 5, Brooks discloses a help area entry containing a location LOC (reads on "page identifier") and a name NAME (reads on "object identifier"), wherein the name corresponds to the name of a particular help module in a help object (Fig. 4 and col. 6 lines 31-35), wherein the area actually used for a given cursor location is found by searching a list of entries in order, and designating the first entry whose LOCation includes the actual position of the cursor as the LOC. Furthermore, each help module is associated with help text mapped to the cursor text and displayed in a display screen (see Abstract, Fig. 4 # 416-417, 420, and 440-441, and col. 10 line 48 to col. 12 line 8).

As per the recitation of an "index table," note the discussion above in the rejection of claim 1 related to an index table as disclosed by Ryan.

The remainder of claims 4 and 5 repeat the same limitations as claim 1, and are therefore rejected for the same reasons given for claim 1. The motivation for combining Brooks into Ryan is given above in claim 1, and incorporated herein.

(E) As per claim 6, Brooks discloses a help object comprised of a module name (Fig. 4 see #440-441) (reads on "header"). The remainder of claim 6 repeats the same limitations as claims 1 and 4-5, and is therefore rejected for the same reasons given for those claims.

(F) As per claim 7, Brooks discloses a help object comprised of help text (Fig. 4 see #440-441). The remainder of claim 7 repeats the same limitations as claims 1 and 4-5, and is therefore rejected for the same reasons given for those claims.

(G) As per claim 9, Ryan discloses context sensitive, hypertext linked help records comprised of context keywords and hyperlink keywords in addition to help text (col. 26 lines 20-30). It is noted the help records of Ryan are considered to be a form of "guidebook comprising a plurality of terms used in insurance claims processing." The remainder of claim 9 repeats the same limitations as claim 1, and is therefore rejected for the same reasons given for claim 1.

(H) As per claims 10-12, Brooks discloses providing a search index panel, wherein the search index accepts words or phrases to search for in an index object from a user,

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wherein the index object is comprised of a synonym table, root table, and topic table, wherein the user types a word or phrase describing possible subjects of interest into an input field and then presses the enter key, wherein the help facility parses the input phrase into individual words, wherein the help facility then finds all modules of help text relevant to the words in the input phrases, and constructs an ordered list of their titles based on the number of correspondences between all input search words and the index terms in each help module describing that module, and wherein displaying the list in a panel (Fig. 2E and 4 and col. 4 line 35 to col. 5 line 3). The motivation for combining Brooks with Ryan is given above in claim 1, and incorporated herein.

(I) Claim 13 appears to be a compilation of the features of claims 1 with the features of claims 4 and 5, and are therefore rejected for the same reasons given for claims 1 and 4-5, in combination.

(J) Claim 14 appears to be a compilation of the features of claims 1 and 2 with the features of claims 4 and 5, and are therefore rejected for the same reasons given for claims 1-2 and 4-5, in combination.

(K) Claim 15 repeats the same limitations as claim 3, and is therefore rejected for the same reasons given for claim 3, and incorporated herein.

(L) Claim 16 appears to be a compilation of the features of claim 3 with the features of claims 4 and 5, and are therefore rejected for the same reasons given for claims 3-5, in combination.

(M) As per claims 17-19, Brooks discloses providing individual entries into fields when using an application, wherein the location (LOC) of the fields (reads on "page identifier") is determined, wherein each help-area entry containing the LOC also includes a name which corresponds to the name of a particular help module in a help object (Fig. 4, col. 1 lines 23-34, col. 2 lines 18-33, col. 2 line 65 to col. 3 line 2, col. 3 line 23 to col. 4 line 58, col. 6 line 36-46, col. 7 lines 42-49, col. 8 lines 14-21, col. 9 lines 53-57, col. 10 lines 4-36, and col. 10 line 47 to col. 11 line 42). Furthermore, Brooks discloses sorting module names into an ordered list sequenced according to how many times its TOPIC was accessed in the topic table (col. 10 lines 17-36). It is noted that the LOC for determining a location of a cursor within an application (Fig. 4 and col. 6 lines 31-46) is considered to be a form of a "content item code." The remainder of claims 17-19 repeat the same limitations as claims 1-5, and are therefore rejected for the same reasons given for those claims, and incorporated herein. The motivation for combining Brooks with Ryan is given above in claims 1-5, and incorporated herein.

(N) Claims 20-23 repeat the same limitations as claims 6-9, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

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(O) Claim 24-27 differs from claims 13 and 14 by reciting a plurality of page identifiers.

As per this recitation, it is noted that in the rejections of claims 13 and 14 address multiple page identifiers. Note, Brooks discloses more than one location identifier (see Figure 4 #417 and col. 6 lines 31-46). The remainder of claims 24-27 repeat the same limitations as claims 1, 3, 14, and 16-17, and are therefore rejected for the same reasons given for those claims, and incorporated herein. The motivation for combining Brooks with Ryan is given above in claims 1 and 13, and incorporated herein.

(P) As per claim 28, Ryan and Brooks fail to expressly disclose determining a total number of the page identifier and content item codes that occur in each of the located first plurality of help information entries and second plurality of help information entries and displaying the first plurality of units of help information and the second plurality of units of help information on the display in order of the determined total number of the page identifier and content item codes that occur in each unit of help information.

However, Brooks includes sorting module names into an ordered list sequenced according to how many times its TOPIC was accessed in the topic table (col. 10 lines 17-36). It is respectfully submitted that displaying search results in order of their relevance based on the number of terms, codes, or identifiers occurring in each document is typically used when searching a database based on a keyword search, and the skilled artisan would have found it an obvious modification to include sorting the results based on the page identifiers and content codes with the motivation of

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increasing user search results and reducing the time in searching by ordering help information based on relevance (Ryan; col. 2 lines 40-45 and col. 4 lines 44-48).

(Q) Claims 29-31, 33, and 36-39 repeat the same limitations as claims 1-4 and 6-10, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(R) As per claims 32 and 34-35, Brooks discloses an index object having many root words and many synonym words for each root word, wherein the synonyms are useful not only for specifying variants for a particular term, but also for translating modules into different languages, where the root words may be left in the original language, and only the synonyms need to be translated, and additionally, dialect or slang terms may be made synonyms as well as common misspellings (Fig. 4 and col. 5 lines 37-59).

Furthermore, Brooks discloses at least one index object or file stored in the system, including a plurality of synonym table entries each associating a synonym word specifying a potential search argument by said user with a root word associated with at least one of said help modules, a plurality of root table entries each associating one of said root words with a topic pertaining to one of said help modules, and a plurality of topic table entries each associating one of said topics with one of said help modules, wherein a synonym word is associated with an associated help module if and only if said synonym word is associated with an associated root word by a synonym table entry, said associated root word is associated with an associated topic by a root word

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table entry, and said associated topic is associated with said associated help module by a topic table entry;

a search argument input means, coupled to said display and to said input device, for displaying an index input panel and for accepting from said user at least one of said synonyms as search arguments;

an index-sensitive selection means, coupled to said display and to said input device, for displaying a list panel listing those of said help modules associated with said search argument synonyms by said index object or file, and for accepting from said user a designation of at least one of said modules for presentation from said help object on said display, said index-sensitive selection means being responsive to said search argument input means; and

a help display means for displaying information contained in a selected help module, said help display means being responsive to the context-sensitive selection means and the index-sensitive selection means (col. 10 line 48 to col. 11 line 41).

The motivation for combining Brooks with Ryan is given above in claim 1, and incorporated herein.

(S) Claims 40-42 repeat the same limitations as claims 3, 10-12, 24, 29, and 31, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

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(T) Claim 43 appears to differ from method claim 1 by reciting hardware elements, namely, a computer system including a memory medium, a display device coupled to the computer system, one or more input devices coupled to the computer system, a help database, and an insurance claims processing program storing in the memory medium and executable within the computer system. As per these elements, Ryan discloses:

(a) a digital computer including memory for initiating, processing, preparing, storing, and transmitting illustrations of universal life insurance (Abstract, col. 11 lines 8-14, and col. 51 line 52-55);

(b) I/O devices (col. 11 lines 8-14 and col. 51 line 52-55);

(c) a terminal with data input screens coupled to the digital computer (Fig. 1);

(d) providing a computerized help system, preferably a context sensitive, hypertext-linked help system, available from any screen in the system, wherein the system includes a FMA_HELP entity containing all context sensitive, hypertext linked help records including context keywords and hyperlink keywords in addition to the help text that enables these features, and wherein the entity is part of a relational database (reads on "an index table") (Fig. 3C-1 and 4A, col. 14 lines 37-40, col. 23 lines 1-5, col. 24 lines 1-20, and col. 26 lines 20-50); and

(e) a program, comprising a series of instructions, which is stored in memory to which the processor has access, wherein the processor executes the instructions (col. 11 lines 15-30).

The remainder of claim 43 repeats the same limitations as method claim 1, and is therefore rejected for the same reasons given for claim 1, and incorporated herein.

(U) System claims 44-80 repeat the same limitations as claims 1-43, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(V) Claim 81 repeats the subject matter of method claim 1, respectively as a carrier medium comprising program instructions, wherein the program instructions are computer executable to carry out the series of steps from method claim 1. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Ryan and Brooks in the rejection of claim 1, it is readily apparent a digital computer including memory for initiating, processing, preparing, storing, and transmitting illustrations of universal life insurance (Abstract, col. 11 lines 8-14, and col. 51 line 52-55), wherein a program, comprising a series of instructions, which is stored in memory to which the processor has access, and wherein the processor executes the instructions (col. 11 lines 15-30) disclosed by Ryan provides the means to carry out these steps. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(W) Carrier medium claims 82-110 repeat the same limitations as claims 1-42 and 81, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a method and system for image storage and retrieval (4,553,206), a method and apparatus for facilitating operation of an insurance plan (4,837,693), a method and system for storage and retrieval of image objects (5,093,911), a method and apparatus for displaying context sensitive help information on a display (5,155,806 and 5,157,768), a multimedia search system using a plurality of entry path means which indicate interrelatedness of information (5,241,671), a method and apparatus for providing help information to users of computers (5,287,448), a financial spreadsheet with context and layout sensitive help screens (5,471,575), a method and system for instructing a user of a computer system how to perform application program tasks (5,481,667), a method of and system for displaying context sensitive and application independent help information (5,535,323), a user interface for information retrieval system (5,768,578), a method and system for automated data storage and retrieval with uniform addressing scheme (5,895,461), systems and methods for retrieving tabular data from textual sources (5,950,196), and an information retrieval system from hierarchical compound documents (5,991,756).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

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3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

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January 3, 2003

Dinh X. Nguyen
DINH X. NGUYEN
PRIMARY EXAMINER